

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT

WRITTEN OPINION OF THE
INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY
(PCT Rule 66)

Date of mailing (day/month/year)	10.11.2005
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Applicant's or agent's file reference
E-2437/04

REPLY DUE **within 1 month(s)**
from the above date of mailing

International application No.
PCT/EP2004/052559

International filing date (day/month/year)
15.10.2004

Priority date (day/month/year)
17.10.2003

International Patent Classification (IPC) or both national classification and IPC
F16G1/28, B29D29/08, B29C67/24, C08L15/00, C08L27/18

Applicant
DAYCO EUROPE S.R.L. CON UNICO SOCIO

1. ☒ The written opinion established by the International Searching Authority:
 ☒ is ☐ is not
 considered to be a written opinion of the International Preliminary Examining Authority

2. This second report contains indications relating to the following items:
- ☒ Box No. I Basis of the opinion
 - ☐ Box No. II Priority
 - ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - ☐ Box No. IV Lack of unity of invention
 - ☒ Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - ☒ Box No. VI Certain documents cited
 - ☒ Box No. VII Certain defects in the international application
 - ☒ Box No. VIII Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(e).
How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.
Also: For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis. For an informal communication with the examiner, see Rule 66.6. For an additional opportunity to submit amendments, see Rule 66.4.
If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 69.2 is: 17.02.2006

Name and mailing address of the international preliminary examining authority:



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**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

International application No.
PCT/EP2004/052559

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This opinion is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements** of the international application, this opinion is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed")*:

Description, Pages

1-10 as originally filed

Claims, Numbers

1-7 as originally filed

Drawings, Sheets

1/1 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):

**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

International application No.
PCT/EP2004/052559

Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	4-6
	No: Claims	1-3,7
Inventive step (IS)	Yes: Claims	
	No: Claims	1-7
Industrial applicability (IA)	Yes: Claims	1-7
	No: Claims	

2. Citations and explanations:

see separate sheet

Box No. VI Certain documents cited

1. Certain published documents (Rule 70.10)

and / or

2. Non-written disclosures (Rule 70.9)

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

- 1.1 Reference is made to the fax of reply dated and received on 31.10.2005.
- 1.2 Further reference is made to the following documents:

D1: EP-A-1052425
D2: EP-A-1157813
- 1.3 Claim 1 is restricted to a fabric coated on the outside with and directly adhered to a resistant layer (a) and to a resistant layer comprising a fluorinated plastomer, an elastomeric material and a vulcanizing agent (b). These features are as such disclosed by D1 as pointed out under paragraph 2.1 herein under. The conclusion and arguments of page 2 of the letter of reply cannot be shared by the examining instance, because the evaluation of claim 1 in respect of Article 33(2) PCT can only be carried out on the basis of that what is constituting the definition of the subject-matter of claim 1, see also PCT-Guidelines 5.20 and 5.31.
- 1.4 Since no additional arguments in respect of D1 are provided for evaluating the novelty of claim 7 in the sense of Article 33(2) PCT, the examination instance can at present not see grounds for altering its opinion as brought forward under paragraph 2.2 herein below.
- 1.5 The deficiencies brought forward under Items VII and VIII remain outstanding.
- 1.6 If the applicant can see a possibility of overcoming the aforementioned objections a set of amended claims can be filed. Although it is preferable, that the independent claims are to be drafted in the two-part form in accordance with Rule 6.3(b) PCT, with the features known in combination from the prior art document in its preamble (Rule 6.3(b)(i) PCT) and with the remaining features being included its characterizing part Rule 6.3(b)(ii) PCT), the examining instance can at present not indicate which

features are to be put in the preamble or the characterizing portion, since there is a difference in opinion regarding the document representing the closest prior. The applicant should in any case indicate in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art and the significance thereof.

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34(2)(b) PCT, the applicant is requested to clearly identify the amendments carried out, no matter whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based (see also Rule 66.8(a) PCT).

If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.

The applicant is requested to file the amendments by way of replacement pages in the manner stipulated by Rule 66.8(a) PCT. In particular, fair copies of the amendments should be filed preferably in triplicate.

Moreover, the applicant's attention is drawn to the fact that, as a consequence of Rule 66.8(a) PCT the examiner is not permitted to carry out any amendments under the PCT procedure, however minor these may be.

2. The following is stated under reference to Item VIII of this opinion. It is to be noted, that those features, which cause non-compliance with Article 6 PCT, can formally not be employed for unambiguously distinguishing over prior art for assessing novelty in the sense of Article 33(2) PCT or inventive step in the sense of Article 33(3) PCT.
- 2.1 Document D1, cf. figure 2, example C5 and paragraph [0053] discloses a toothed belt comprising a body (32) and a plurality of teeth (18), said teeth being coated with a fabric (24), said fabric being coated on the outside with a resistant layer, said resistant layer comprising a fluorinated plastomer (41), an elastomeric material and a vulcanizing agent, said fluorinated plastomer (41) being present in said resistant layer

in an amount higher (200 phr) than that of said elastomeric material, whereby said fluorinated plastomer (41) is formed by particles of average size smaller than 10 μm (0.25 μm) and said resistant layer is made to adhere directly to said fabric (24).

Therefore the subject-matter of claim 1 for as far as can be understood lacks novelty and claim 1 does not meet the requirements of Article 33(2) PCT.

- 2.2 A process for fabrication of a toothed belt according to claim 1, whereby said resistant layer is made to adhere directly to said fabric (24) via spreading is known from D1, see for instance paragraph [0025].

Therefore the subject-matter of claim 7 is deprived of novelty and claim 7 does not meet the requirements of Article 33(2) PCT.

- 3.1 Due to the lack of novelty of independent claims 1 and 7 in the sense of Article 33(2) PCT as set out herein above under paragraph 2, it is questionable whether the requisite unity of invention in the sense of Rule 13(1) PCT in respect of the subject-matter of claims 2, 3 and 5, which formally directly depend on claim 1, still exists.

Consequently the international searching authority cannot identify in this written opinion, which of the additional features contained by dependent claims 2 - 6 or combinations thereof could in reason support the presence of an inventive step in the sense of Article 33(3) PCT.

In this respect further reference is made to the PCT-Guidelines 13.14(c), wherefrom it can be concluded, that a juxtaposition or an association of known features without a surprising or unexpected effect caused by an interrelationship of such features as such not lead to the conclusion of the presence of an inventive step.

- 3.2 For the aspects concerning the requirements of Article 33(2) PCT of these additional features in accordance with the present claim structure, reference is made to the citations in the International Search Report.

**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY
(SEPARATE SHEET)**

International application No.

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4. Claims 1 - 7 meet the requirements of Article 33(4) PCT.

Re Item VI

Certain documents cited

Certain published documents

Application No Patent No	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
EP-A-1396658	10.03.2004	07.09.2002	07.09.2002

Re Item VII

Certain defects in the international application

1. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in document D1 is not mentioned in the description, nor is this document identified therein.

Re Item VIII

Certain observations on the international application

In respect of the requirements of Article 6 PCT the following is observed.

1. The feature "a vulcanizing agent", cf. claim 1, appears to be a raw material feature rather than a resistant layer feature. This feature causes therefore formally a lack of clarity of the subject-matter of the claim, see also the PCT-Guidelines, 5.26.

- 2.1 The expression "mainly by particles of average size" as used in claim 1, lines 10 and 11 causes a lack of clarity of the subject-matter of claim 1, because the word mainly cannot be correctly interpreted in terms of quantified mass, volume or other numbers (does it for instance imply more than 50 weight percent or more than 50 vol.-% or more than 50%, 60%, 70%, etc) and because of the fact that the sequence of "mainly average size" or "50% having an average size" cannot teach any average size, cf. the PCT-Guidelines, 5.20 and 5.38. Basis for amendment can be found on page 6, last paragraph and example 3.
- 2.2 Similar accounts for the expression "an amount higher", cf. page 11, line 9, for which a basis for amendment is contained by claim 5.